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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,927	08/08/2007	Tillman Pulina	58653/02209	5390

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KRAMER LEVIN NAFTALIS & FRANKEL LLP  
INTELLECTUAL PROPERTY DEPARTMENT  
1177 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036

EXAMINER
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STALDER, MELISSA A

ART UNIT	PAPER NUMBER
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1793

NOTIFICATION DATE	DELIVERY MODE
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03/17/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

klpatent@kramerlevin.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/591,927	<b>Applicant(s)</b> PULINA ET AL.	
	<b>Examiner</b> MELISSA STALDER	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner interpreted claim 15 to be dependent upon claim 1 as the dependency as written does not make sense because the ester cannot be both an ester of citric acid and a butyl ester. Applicant should either correct the dependency or rewrite the claim to clarify the limitation.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Iwase (JP 2002121452, Machine English translation and English translation of abstract). Iwase teaches an offset printing ink where the solvent is made of a diester compound of a dibasic acid (such as azelaic acid, for example (0016)) with an alcohol such as 1,3-pentanediol (0013-0017). Inherently a polycarboxylic acid will have at least 2 carboxylic acid groups.

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Regarding claims 2-4, Iwase teaches that the fatty acid monoester is 40-60 wt. % of the solvent ingredients (0025).

Regarding claim 6, Iwase teaches the use of an ester compound of an aliphatic diol that has a boiling point over 150 degrees C and is liquid at room temperature. Therefore, this encompasses aliphatic alcohols with at least 6 carbon atoms.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 14, and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwase (JP 2002121452, Machine English translation and English translation of abstract) as in claims 1-7 above, further in view of Opre (US 6,284,720). Opre teaches a biodegradable solvent where an organic co-solvent is an ester of citric acid (a polycarboxylic acid with 3 carboxylic acid groups) (col. 2, lines 63-65). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the citric acid of Opre with the composition of Iwase because Opre teaches the environmental benefits of a biodegradable solvent.

Regarding claims 16-18, Opre teaches the use of coconut oil as the ester in the ester based solvent (col. 3, lines 53-61).

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Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwase (JP 2002121452, Machine English translation and English translation of abstract) as in claims 1-7 above, further in view of Nito (US 6,932,465). Nito teaches the use of trimellitic acid as part of the buffer in a reaction solution to be used with ink when printing (col. 1, lines 9-14; col. 5, lines 11-22). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the trimellitic acid of Nito with the composition of Iwase because Iwase teaches that control of the pH helps image quality (col. 3, lines 29-35).

Claims 12 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Iwase (JP 2002121452, Machine English translation and English translation of abstract) as in claims 1-7 above, further in view of Arnaud (US 2004/002840). Arnaud teaches the production of a cosmetic such as a gloss with tridecyl trimellitate as the ester in the oil used in the cosmetic (0061-0070). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the ester of Arnaud with the composition of Iwase because Arnaud teaches a high gloss, non-sticky composition that is safe for human contact. Further the oil used in Arnaud is a solvent.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iwase (JP 2002121452, Machine English translation and English translation of abstract) as in claims 1-7 above, further in view of Bergomi (US 3,665,060). Bergomi teaches the use of a butyl ester in an adhesive or binder in a pigment coating composition where the

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butyl ester is an ester of a polycarboxylic acid (maleic acid) and produces a secondary butyl ester (Examples 6 and 7). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the ester of Bergomi with the composition of Iwase because Bergomi teaches that the composition is particularly useful in pigment coating compositions for paper and paperboard (col. 1, lines 5-14; Example 7).

Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwase (JP 2002121452, Machine English translation and English translation of abstract) as in claims 1-7 above, further in view of Isenberg (US 2,389,781). Isenberg teaches the use of coconut oil in a luminescent coating material (col. 4, line 56-col. 5, line 9). The coconut oil can be used with the ester as part of the vehicle of the pigment (col. 4, lines 36-55). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the coconut oil of Isenberg with the composition of Iwase because Isenberg teaches that coconut oil causes luminescence of the pigment for use in a paint (col. 1, lines 7-16).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA STALDER whose telephone number is (571)270-5832. The examiner can normally be reached on Monday-Friday, 8:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Melvin Curtis Mayes can be reached on 571-272-1234. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MS

March 11, 2009

/Melvin Curtis Mayes/

Supervisory Patent Examiner, Art Unit 1793